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OFFICE OF PETITIONS

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In re Patent of Jae K. Rhee et al.	:	DECISION ON REQUEST
Patent No. 7,816,379	:	FOR RECONSIDERATION OF
Issue Date: October 19, 2010	:	PATENT TERM ADJUSTMENT
Application No. 10/596,412	:	AND NOTICE OF INTENT TO
Filing Date: June 13, 2006	:	ISSUE CERTIFICATE OF
Attorney Docket No. TRIUS.002NP	:	CORRECTION

This is a decision on the request filed October 6, 2010, and supplemented on December 20, 2010, which is being treated as a petition under 37 C.F.R. § 1.705(d) requesting the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by one thousand one hundred sixty-three (1,163) days.

The petition to correct the patent term adjustment indicated on the patent to indicate the term of the patent is extended or adjusted by one thousand one hundred sixty-three (1,163) days is **GRANTED**.

Background

The instant application is the national stage of International Application No. PCT/KR04/03327, and fulfilled the requirements of 35 U.S.C. § 371 on June 13, 2006.

The Office issued a non-final Office action on March 6, 2008.

Applicants filed a reply on March 19, 2008.

The Office issued a second non-final Office on June 23, 2008. The Office action inadvertently set a shortened statutory period for reply of one month instead of three months.

An August 4, 2008 interview summary form prepared by the examiner summarizes a July 30, 2008 telephonic conference between Patent Examiner Patricia Morris, Supervisor Patent Examiner Janet Andres, and Attorney Joseph Mallon. The interview summary form states,

SPE Andres confirmed that the response time for the action mailed 23 June 2008 should have been three months, not one month as was indicated in the Office Action Summary. The time has further been reset so that a response is due on 11/04/08.

An information disclosure statement ("IDS") was filed October 31, 2008. The IDS was not accompanied by a statement under 37 C.F.R. § 1.704(d) and the record fails to indicate the examiner expressly requested the IDS.

The Office issued a third non-final Office action on December 16, 2008. The cover page of the Office action states it is "[r]esponsive to communication(s) filed on 1[9] March 2008." The December 16, 2008 Office action is substantively the same as the June 23, 2008 Office action except the December 16, 2008 Office action states, "The previous Office action mailed on June 23, 2008 is hereby vacated."

The Office issued a fourth Office action on January 29, 2009, prior to Applicants filing a reply to the December 16, 2008. The fourth Office action states, "Julie Burke, SPRE has directed that the restriction requirement be rewritten to include claims 17, 21 and 22 with claims 18-22 based on an alleged conversation with applicants."

The Office issued a fifth Office action on February 11, 2009. The Office action states,

The previous office action mailed 29 January 2009 is hereby vacated. A new action on the merits follows.... On consideration, the restriction requirement among groups XII-XIV set forth in the office action of 6 March 2008 is withdrawn. Claims 17-22 and 36-46 are rejoined and are under examination in this office action.

Applicants filed an amendment on May 11, 2009

Applicants filed an IDS on June 1, 2009. Applicants also filed an IDS on July 6, 2009. Neither IDS includes a statement under 37 C.F.R. § 1.704(d). The record does not indicate the examiner expressly requested Applicants file either IDS.

The Office issued a final Office action on August 13, 2009.

Applicants filed an amendment on August 27, 2009.

The Office issued an Advisory Action on September 4, 2009.

Applicants filed a petition, Notice of Appeal, and a Pre-Appeal Brief Request for Review on September 14, 2009. The petition included an objection to a new restriction requirement set forth in the August 13, 2009 Office action.

The Office issued a decision in response to the petition on October 8, 2009. The decision states,

The final Office action mailed 13 August 200[9] is hereby vacated.

Because the final Office action has been vacated, the amendment filed 27 August 2009 will be entered.

A pre-appeal conference will be held shortly to discuss the rejections of record over claims 51 and 52.

The application will be forwarded to the examiner for preparation of an Office action on all pending claims consistent with this decision.

The Office issued a Notice of Panel Decision from Pre-Appeal Brief Review on October 20, 2009. The notice states, "The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed."

The Office issued an Interview Summary form on December 17, 2009, which summarizes a November 19, 2009 telephonic interview between Quality Assurance Specialist ("QAS") Julie Burke and representatives Joseph Mallon and Carolyn Favoriton. The Interview Summary form states, with emphasis added,

Applicant called to clarify the status of several actions in terms of potential Patent Term Adjustment. The Office has mailed out a series of Office actions, **vacated** from the record for the following reasons.

The Restriction Requirement mailed 3/6/08 is hereby **vacated**....

The Office action mailed 6/23/08 was **vacated** by the Office action mailed 12/16/0[8]....

The Office action mailed 12/16/0[8] is hereby **vacated**....

The Office action mailed 1/29/09 was **vacated** by the Office action mailed 2/11/09....

The Supplemental Office action mailed 2/11/09 is hereby **vacated** as incomplete....

The final Office action mailed 8/13/09 was **vacated** in the petition decision mailed 10/08/09.

[T]he advisory action mailed 9/4/09 ... was improper and is hereby **vacated** from the record....

Finally, the Notice of Appeal filed on 9/14/09 is considered untimely under 37 CFR 41.31(a) because the claims have not been rejected twice on the merits.... Applicants are encouraged to request a refund of the fees paid for filing the Notice of Appeal.

The Office regrets the delays and inconvenience which occurred during prosecution of this application and **hopes this helps simplify the processing of Applicants PTA adjustments.**

On an uncertain date, an unknown individual annotated several entries in the Office's electronic file for the application by adding the phrase "vacated from record." The annotated entries are

associated with Office actions issued March 6, 2008; June 23, 2008; December 16, 2008; January 29, 2009; February 11, 2009; August 13, 2009; and September 14, 2009.

The Office issued a Notice of Allowance on December 24, 2009. The Notice of Allowance included a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) advising Applicants of a patent term adjustment to date of 138 days.

A petition under 37 C.F.R. § 1.705(b) was filed January 12, 2010. The petition requested the initial determination of patent term adjustment be corrected from 138 days to 864 days.

Applicants submitted the issue fee on March 5, 2010.

The Office issued a decision in response to the January 12, 2010 petition on September 14, 2010. The decision stated the correct patent term adjustment, as of the issuance date of the Notice of Allowance, was 254 days, which is the sum 206 days of delay under 37 C.F.R. § 1.703(a)(1) and 104 days of delay under 37 C.F.R. § 1.703(a)(2) reduced by 56 days of delay under 37 C.F.R. § 1.704(c)(8).

The application issued as Patent No. 7,816,379 on October 19, 2010. The patent sets forth a patent term adjustment determination of 646 days.

The instant petition was filed October 6, 2010, and supplemented on December 20, 2010.

Analysis

The petition asserts the correct patent term adjustment is 1,163 days.

In view of specific facts and circumstances in this case, the Office is persuaded the proper patent term adjustment is 1,163 days. Therefore, the Office will issue a certificate of correction setting forth a patent term adjustment of 1,163 days.

The instant decision is based on the *specific* facts and circumstances of the instant case. In other words, similar facts and circumstances may result in a substantially different decision in view of the discussion set forth below.

The vacatur of an Office action sets aside or withdraws any rejection, objection or requirement in an Office action, as well as the requirement that the applicant timely reply to the Office action to avoid abandonment of the application under 35 U.S.C. § 133. In other words, the vacatur of an Office action signifies that the Office action has been set aside, voided, or withdrawn as of the date of the vacating Office action or notice. The vacatur of an Office action, however, does **not** signify that the vacated Office action is void *ab initio* and is to be treated as if the USPTO had never issued the Office action. The patent examination process provided for in 35 U.S.C. §§ 131 and 132 contemplates that Office actions containing rejections, objections or requirements will be issued, and that the applicant will respond to these Office action, “with or without amendment.” 35 U.S.C. § 132(a). The mere fact an examiner or other USPTO employee, upon further reflection determines an Office action, a rejection, an objection, or a requirement in an

Office action, is not correct and must be removed does not warrant treating the Office action as void *ab initio* and as if the USPTO had never issued the Office action.

The USPTO appreciates that there are situations in which it is appropriate to treat an Office action or notice issued in an application as void *ab initio* and as if the USPTO had never issued the Office action. However, these are extremely rare situations, such as the issuance of an Office action or notice by an employee who does not have the authority to issue that type of Office action or notice, the issuance an Office action or notice in the wrong application, or the issuance of an Office action or notice containing language not appropriate for inclusion in an official document. In essence, the situations in which it is appropriate to treat an Office action or notice issued in an application as void *ab initio* and as if the USPTO had never issued the Office action are the situations in which it is appropriate to expunge an Office action or notice from the USPTO's record of the application.

Conclusion

The Office has considered all the facts and circumstances in this case and is persuaded the proper patent term adjustment is 1,163 days.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by one thousand one hundred sixty-three (1,163) days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 7,816,379 B2
APPLICATION NO. : 10/596,412
DATED : October 19, 2010
INVENTOR(S) : Jae K. Rhee et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the Title page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 646 days.

Delete the phrase "by 646 days" and insert -- by 1163 days--